

REMARKS

This Amendment is responsive to the Office Action mailed on January 6, 2009. Claims 1, 8, 20, and 27 are amended. Claims 39 and 40 are added. Claims 1, 2, 6-21, and 25-40 are pending.

As a preliminary matter, Applicant would like to thank the Examiner for the courteous and productive telephone interview held on March 23, 2009, the details of which are set forth below.

Claims 1, 6, 7, 10-15, 18-20, 25, 29-34, 37, and 38 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gauthier (US 2002/0122205).

Claims 2, 16, 17, 21, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gauthier in view of Sansone (US 6,373,587).

Claims 8, 9, 27, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gauthier in view of Leone (US 2003/0002081)

Applicants respectfully traverse these rejections in view of the amended claims and the following comments.

Summary of March 23, 2009 Telephone Interview with Examiner

During the March 23, 2009 telephone interview, Applicant's undersigned counsel discussed with the Examiner potential claim amendments for overcoming the section 102(e) rejection based on Gauthier. In particular, Applicant's undersigned counsel discussed amending the independent claims to specify that the template is created once the print data is received, in response to the received print. This amendment was suggested in an attempt to distinguish over Gauthier, which clearly indicates that the templates are created and stored at the printer, and, once the print data is received it is merged with the stored template. In contrast, the proposed amendment discussed with the Examiner would clarify that, with the present invention, the template is only created in response to the received print date, so there is no need to provide for

permanent template storage as in Gauthier. The Examiner agreed that such an amendment to the independent claims would appear to overcome Gauthier.

Applicant's counsel also briefly discussed the rejection of claim 8 under section 103(a) as being unpatentable over Gauthier in view of Leone. Applicant's counsel pointed out that in Leone, print data is provided to the printer via a portable memory device, and that this print data is merged with a template stored in the printer (see Abstract). In contrast, with Applicant's claim 8 (and dependent claim 27), a removable memory device is used to provide the template attributes to the printer, not the print data as in Leone. The Examiner agreed that the claim 8 subject matter did not appear to be disclosed in Leone.

The Examiner agreed to review the proposed amendments once filed.

Discussion of Amended Claims

Claim 1 is amended to specify creating at the printer a template from the template attributes in response to received print data, as discussed with the Examiner. Support for this amendment can be found on page 9 of the specification and in Figure 5.

Claim 20, which is an apparatus claim corresponding to claim 1, is amended similarly to claim 1.

Claims 8 and 27 are amended into independent form by the addition of the subject matter of claims 1 and 20, respectively.

New claim 39 is dependent on method claim 1 and specifies verifying all template fields are complete prior to printing the composite image and if the template fields are not complete, monitoring communications from a host computer until additional print data is received and all template fields are complete. Support for this amendment can be found on page 9 of the specification and in Figure 5.

New claim 40 is dependent on apparatus claim 20 and corresponds to new claim 39.

Discussion of Gauthier

Claims 1, 6, 7, 10-15, 18-20, 25, 29-34, 37, and 38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gauthier. This rejection is respectfully traversed. An anticipation rejection requires that each and every element of the claimed invention as set forth in the claim be provided in the cited reference. See *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186 (CA FC 2003), and cases cited therein. As discussed in detail below, Gauthier does not meet the requirements for an anticipation rejection.

Gauthier discloses a method for utilizing variable data with a page description language which enables a template and graphics state for a page of variable data to be defined and stored. A bit map of non-variable background graphics and text, referred to as a template, is generated for the page. At the last code command, which in PostScript is typically SHOWPAGE, the control task terminates the PostScript interpreter and the template is reserved (i.e., stored) in a database (see, e.g., paras. 0009 and 0014). A merge task merges a data bit map into the stored template (see, e.g., para 0015).

As discussed with the Examiner during the telephone interview, the aim of Gauthier is to “have a method for processing variable data wherein once defined, *the template and graphics states for a page can be stored and reused for printing subsequent pages*” (para. 0008, emphasis added). Thus, in Gauthier, the template itself is stored in printer memory 28 for later use once created. Further, in Gauthier, data received for printing is merged into the stored template and the resulting page is printed.

In contrast, with Applicant’s claimed invention according to claim 1, template attributes are provided to the printer memory and the template is created at the printer from the stored template attributes in response to received print data. Thus, with Applicant’s claimed invention, there is no need to store the entire template in memory as in Gauthier. Rather, with Applicant’s claimed invention, the template attributes are provided to the printer memory and the template is created at the printer only after the print data is received, just prior to printing. Such an approach

enables a greater degree of flexibility than that provided by the system of Gauthier, since in Gauthier the printer can only print data in the particular templates that are stored in the memory, while with Applicant's invention the template is created instantaneously by the printer based on the received print data from the stored template attributes, enabling a wide variety of template forms.

Accordingly, Gauthier does not disclose or remotely suggest providing template attributes to memory of the printer and creating the template at the printer from the template attributes in response to received print data, as claimed by Applicant.

The foregoing arguments apply equally to Applicant's independent claim 20, which specifies that the printer comprises a processor for creating a template from the template attributes in response to the received print data.

As Gauthier does not disclose each and every element of the invention as claimed, the rejections under 35 U.S.C. § 102(b) are believed to be improper, and withdrawal of the rejections is respectfully requested. See, *Akamai Technologies Inc., supra*.

Discussion of Section 103(a) Rejection of Claims 8 and 27

Claims 8 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gauthier in view of Leone. The Examiner has acknowledged that Gauthier does not disclose providing template attributes to the printer via a removable memory device, as set forth in Applicant's claims 8 and 27 (Office Action, page 14). As discussed with the Examiner, Leone discloses only the providing of print data to a printer via a portable memory device. Leone does not disclose or remotely suggest providing template attributes (or even a template) to the printer via the portable memory device. Rather, in Leone, the template is already stored at the printer (see Abstract).

Thus, Leone does not disclose or remotely suggest the subject matter of Applicant's claims 8 and 27.

Applicants respectfully submit that the present invention is not anticipated by and would not have been obvious to one skilled in the art in view of Gauthier, taken alone or in combination with any of the other prior art of record.


Further remarks regarding the asserted relationship between Applicants' claims and the prior art are not deemed necessary, in view of the agreement reached with the Examiner during the telephone interview, the amended claim and the foregoing discussion. Applicants' silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.

Withdrawal of the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

The Examiner is respectfully requested to reconsider this application, allow each of the pending claims and to pass this application on to an early issue. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicants' undersigned attorney.

Respectfully submitted,



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